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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,290	08/14/2000	TAKUYA ISHIDA	106379	4252
25944	7590	03/26/2004		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER FLEMING, FRITZ M	
			ART UNIT 2182	PAPER NUMBER 8

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,290

Applicant(s)

ISHIDA ET AL.

Examiner

Fritz M Fleming

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

2. Claims 1-29 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The matter is unclear due to specific wording of the evidence relied upon in the form of 6,578,095 with Tanaka and Ogawa listed as the inventors. The area relied upon is found at column 12, line 44-column 13, line 6, wherein one finds clear reference at line 58 to "this embodiment of the invention" and then lines 62+ which start with "Note that this embodiment could also be configured....it is preferable that a packet is created, consisting of a frame made up of a header (broadly speaking, control information) followed by a string of a plurality of self-ID packets, and this packet is stored in RAM." Furthermore, column 13 goes on to describe the erasing of error detection information, addressed by instant claim 2. The wording read as is seems to indicate that the invention of 6,578,095 includes an embodiment which would include at least the subject matter of instant claims 1 and 2. This raises the issue as to the true inventor(s) of the instant claimed subject matter. There is no inventor overlap, although the assignee appears to be the same. Clarification is respectfully requested.

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being obvious over Tanaka et al.

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The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

As pointed out above, the discussion of the packet forming based upon self-ID renders the packet forming means as obvious. As storage is in RAM, there is a write means obviously present in order to write such to memory. Per column 13, error detection information is erased, hence rendering obvious the limitations of the claim 2 error check information erasure. Although the error check information is erased, it would have been obvious to retain at least the information that an error was present and

append this to the "broadly speaking control information" as the presence of an error is just such a type of information desired to be kept in the header. Per columns 9 and 10, the packet diagnosis circuit 142 detects the self-ID period, again providing information suitable for inclusion in the control header. This would help to ensure proper self-identification. The packet described has a control information header thus placing information in a header and data sections. RAM is taught and the use of pointers is an obvious expedient in order to properly delineate the header from data information sections in the RAM. Obviously area in the RAM is set aside (i.e. dedicated) for just this purpose. Timing detection for self-ID detection is based upon PHY chips, hence information from a lower level of the OSI layer model. Thus only a proper sequence of self-ID is stored to RAM. Furthermore, data in its final format of a packet is used by upper levels of the OSI layer model. IEEE 1394 is mentioned in the abstract. A device in an overall system is shown per 17 and 18.

Conclusion

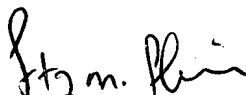
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sescila, III et al. teach a PCI to IEEE 1394 translator. Fukui teaches the use of self-ID in a 1394 bus network to generate a topology map 32 in a zone bridge unit 20 per table 1. Newman et al. teach the handling of self-ID packets, especially noting that column 13 sets forth the relatively large receive FIFO needed to store all of the self-ID packets for later evaluation by the host interface 150. Note also the flow charts of Figures 23-25, with the status registers 164 containing the results of

the self-ID period. WO98/44400 is the equivalent of the Fukui reference with a publication date of 08 October 1998.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fritz M Fleming whose telephone number is 703-308-1483. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-1483. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Fritz M Fleming
Primary Examiner
Art Unit 2182

fmf